

## **Remarks**

Claims 24-48 have been cancelled, and claims 50-65 have been added. Claims 49-65 now stand in the application. Claims 24-48 have been cancelled to allow the present invention to be more clearly defined and in no way affects the applicants' right to pursue the patentability of the subject matter contained in these claims.

Support for new claims 50-65 appear in general throughout the Specification and, in particular, as follows:

<b><u>Claim</u></b>	<b><u>Support</u></b>
50	Original claims 1 and 7; page 4, lines 13-19
51	Original claim 5
52	Original claim 5
53	Original claim 5
54	Original claim 5
55	Original claim 5
56	Page 17, line 21 - page 18, line 1
57	Original claim 6
58	Original claim 4
59	Original claim 9
60	Page 6, lines 26-27
61	Original claim 10
62	Page 7, lines 4-5
63	Original claim 11
64	Original claim 12; Page 4, lines 19-21
65	Original claim 15; Page 4, lines 24-26

## **Restriction**

Applicant's new set of claims is believed to render the restriction moot.

## **Claim Rejections**

Canceled claim 45 stood rejected under 35 USC §102(b) as being anticipated by Cole (US 5,595,782), Struss et al. (US 4,686,253), Williams (US 4,454,267), Wakabayashi et al. (JP H07-206504), Kono et al. (sic Kawano et al.) (JP H06-158047) or Kondrats (US 5,439,608).

Canceled claims 45 and 46 stood rejected under 35 USC §102(b) as being anticipated by Kaplan (US 5,494,947).

Canceled claims 45-48 stood rejected under 35 USC §102(b) as being anticipated by Patel (US 5,653,797) or Trmata (CA 1,117,989).

To the extent that these rejections may be raised with respect to new claims 50-65, Applicant disagrees.

New claim 50 is directed to a drywall joint compound comprising filler, binder, and dust reducing additive added in a sufficient quantity to reduce the formation of particles capable of becoming airborne by sanding the hardened drywall joint compound. None of the cited references disclose such a drywall joint compound.

#### **Cole**

The Cole reference relates to an emulsion which can be sprayed onto a dust generating material such as in mines, on roadways, on playgrounds, on dirt walks, and the like, thereby substantially preventing dust evolution from the dust generating material. The emulsion is applied as a surface coating and forms a dust barrier layer (see Cole col. 6, line 63). Cole, however, does not disclose a joint compound, a sandable compound, or a compound including a dust reducing additive that is added in a sufficient quantity to reduce the formation of dust generated by sanding the compound. Thus, Applicant believes that new independent claim 50 is patentable over Cole.

#### **Struss et al. and Williams**

Both the Struss et al. and Williams references are cited as teaching a joint compound comprising wetting agents/surfactant compounds. The Williams reference relates to a joint compound including a filler, a binder, a specially treated expanded perlite, a non-leveling agent, and a thickener. (*See Williams Abstract*) The primary objective of Williams is to provide a joint compound that is lighter in weight than conventional joint compounds. (*Id.* at col. 5, lines 37-39) The Struss et al. reference is directed to a lightweight joint compound similar to that of Williams except that it has improved paintability characteristics. The improved paintability is achieved by including expanded perlite that has a finer mean particle size than what was used previously by Williams and treating the expanded perlite to render it water repellent. (*See Struss et al. Abstract*)

Williams and Struss et al., however, do not disclose the present invention as defined in new independent claim 50 because they do not disclose a drywall joint compound including a dust reducing additive added in a sufficient quantity to reduce the formation of particles capable of becoming airborne that would otherwise be generated by sanding the hardened drywall joint compound.

Williams and Struss et al. do not mention the word dust, are not concerned with dust reduction, and do not mention or suggest any way of reducing or minimizing the quantity of dust generated by the joint compounds. Accordingly, they fail to “disclose” the invention defined in new independent claim 50. To “disclose” means to expose to view, reveal, or to make known. *Webster's II New College Dictionary* 324 (1995).

Williams discloses, in relevant part:

Additional ingredients generally utilized in joint compounds are preservatives, wetting agents, defoamers, and plasticizers.  
(Col. 3, lines 48-50, emphasis added.)

Similarly, Struss et al. disclose, in relevant part:

Additional ingredients which may be utilized in joint compound are preservatives, wetting agents, defoamers, and plasticizers.  
(Col. 3, lines 40-47, emphasis added.)

Williams and Struss et al. merely disclose or make known that joint compounds may include “preservatives, wetting agents, defoamers, and plasticizers.” These ingredients, however, are optional. Williams and Struss et al. fail to disclose whether any of these ingredients could be used as dust reducing additives, which ones could be used as dust reducing additives, or how much of any particular ingredient would be required for it to serve as an effective dust reducing additive. Williams or Struss et al. also fail to identify any specific preservatives, wetting agents, defoamers, or plasticizers, or the amounts of such specific ingredients that would enable them to serve as dust reducing additives. Thus, Williams and Struss et al. do not reveal or make known (i.e. “disclose”) a joint compound including a dust reducing additive.

In addition, the disclosure in Williams and Struss et al. of a joint compound including wetting agents does not constitute disclosure of a dust reducing additive. The Williams and Struss et al. references offer no guidance as to what is meant by the term wetting agent or why a wetting agent should be included in a particular joint compound formulation. One skilled in the art would therefore expect the term to have its ordinary meaning and that it be used for its ordinary purpose. Accordingly, a wetting agent would be understood to be a "surface-active agent that, when added to water, causes it to penetrate more easily into, or to spread over the surface of, another material by reducing the surface tension of the water. Soaps, alcohols, and fatty acids are examples." *Hawley's Condensed Chemical Dictionary* 1179 (13<sup>th</sup> ed. 1997)

From this definition, one would not know to add a wetting agent to a compound in an attempt to reduce dust nor would one expect wetting agents to provide any dust reducing effect. Moreover, even if one were inclined to add a wetting agent to reduce dust, the term "wetting agent" is a very broad and encompasses a wide range of potential ingredients from which one would be required to choose. Williams and Struss et al. fail to disclose any specific wetting agents, fail to disclose any wetting agents that may be used as a dust reducing additive, fail to disclose how much of a particular wetting agent would need to be added in order for it to serve as a dust reducing additive once a particular wetting agent had been identified, and even fails to disclose why the addition of a wetting agent is contemplated. Because Williams and Struss et al. fail to disclose whether a wetting agent should be included in the joint compound formulation, whether wetting agents could serve as dust reducing additives, have failed to identify any specific wetting agents which could be used as dust reducing additives, and have failed to disclose how much of a particular wetting agent should be included in the formulation to serve as a dust reducing additive, new independent claim 50 is patentably distinguishable there from.

Although Applicant does not believe Williams and Struss et al. disclose a drywall joint compound including a dust reducing additive, assuming *arguendo* that they do, prior accidental production of an invention, where the character and function of the invention were not recognized, does not constitute anticipation. *Ralph W. McKee and Harold Perpall v. Graton & Knight Co.*, 32 U.S.P.Q. 89, 91 (4<sup>th</sup> Cir. 1937). Since any prior production of a drywall joint compound with a dust reducing additive by Williams and Struss et al. would have been purely accidental, and since Williams and Struss et al. did not recognize or appreciate the character or

function of such a compound or the method by which it was made, it follows that Williams and Struss et al. do not anticipate or in any way render the present invention as defined in new independent claim 50 unpatentable. Stated another way, if a joint compound including a dust reducing additive was accidentally and unwittingly produced by Williams or Struss et al., while the investigators were in pursuit of other and different results, without exciting attention and without it even being known what was done or how it had been done, it would be absurd to say that this was an anticipation of the present invention. *See, Tilghman v. Proctor* (1881).

If the alleged anticipating joint compounds included a dust reducing additive, that fact, so far as the references show, was not known to those who produced it or used it, and not being recognized as a new product with its distinctive characteristics, its production was purely an accident without profit to the art and without value as an anticipation. *Pittsburgh Iron & Steel Foundries Co. v. Seaman-Sleeth Co.*, 248 F. 705, 709 (3d Cir. 1918).

The fact that Williams and Struss et al. did not recognize or appreciate a joint compound including a dust reducing additive is evident from the fact that the joint compounds in each reference were tested for a wide variety of properties including ease of trowel application, hand sanding properties, cracking and fissure resistance, bonding to a liquid-permeable tape, edge delamination, resistance to deterioration under humid conditions, ease of mechanical sanding, shelf life, and freeze-thaw stability. (See Williams col. 4, lines 27-32, and Struss et al. col. 4, lines 23-28) The references, however, are completely silent with respect to dust, dust generation, and dust reduction. References that are silent with respect to a claimed feature cannot be said to disclose that feature. Because Williams and Struss et al. do not mention the word dust, are not concerned with dust reduction, and do not mention or suggest any method of reducing dust, they fail to disclose the invention defined in new independent claim 50.

It is further noted that when a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate. *Mendenhall v. Astec Industries, Inc.*, 13 U.S.P.Q. 2d 1913, 1928 (Tenn. 1988), *aff'd*, 13 U.S.P.Q.2d 1956 (Fed. Cir. 1989). Again assuming *arguendo* that Williams and Struss et al. may disclose a dust reducing additive, one would be required to pick and choose from the optional ingredients listed (i.e. preservatives, defoamers, wetting agents, and plasticizers), would be required to pick and choose the specific

ingredient within each category of ingredients listed (i.e. the specific defoamer, the specific wetting agent (e.g. the specific soap, alcohol, or fatty acid), the specific preservative, etc., and would have to pick and choose the amount of each ingredient to be used in order to formulate a drywall joint compound including a dust reducing additive capable of reducing the formation of airborne dust particles. In fact, the Office Action itself supports the conclusion that Williams and Struss et al. do not anticipate the present invention because the Examiner was required to choose wetting agents from the list of optional ingredients (i.e. preservatives, defoamers, wetting agents, and plasticizers) disclosed in the reference. Accordingly, Williams and Struss et al. do not anticipate or in any way render the present invention unpatentable.

The Williams and Struss et al. references also fail to provide an enabling disclosure of the claimed invention. A reference itself must have an enabling disclosure to be used as a proper reference. 35 U.S.C. §102(b) has been interpreted as requiring the description of the invention to be sufficient to put the public in possession of the invention. *Ex Parte Gould*, 231 U.S.P.Q.2d 943 (B.P.A.I. 1986). A reference anticipates a claim only if the reference discloses the claimed invention “such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.” *In re Graves*, 36 U.S.P.Q.2d 1697, 1701 (Fed. Cir. 1995). Since the Williams and Struss et al. references contain no mention of dust generation, dust reduction, dust reducing additives, providing drywall joint compounds including a dust reducing additive, or adding dust reducing additives to drywall joint compounds, there is no way that one skilled in the art of drywall joint compounds could, without the benefit of the present invention, take the teachings of the references in combination with his own knowledge of the particular art and be in possession of the present invention.

In addition, since the Williams and Struss et al. references provide no direction or guidance regarding the use of wetting agents, and one could not practice the present invention without undue experimentation, it further follows that Williams and Struss et al. do not provide an enabling disclosure of the present invention. It is only through hindsight and reading in the teachings and insights learned from the present application that Williams and Struss et al. could be construed as having disclosed the present invention.

### **Wakabayashi et al. and Kawano et al.**

The Wakabayashi et al. and Kawano et al. references relate generally to solidification materials capable of preventing dispersal of dust. While it is not entirely clear from the specifications what dust problem they attempt to address, each reference appears to relate to either: (1) soil improvers which are mixed with soil produced from a construction site to improve the roadbed and to prevent dust from dispersing when paving roads (*see* Wakabayashi et al., para. 0005 and 0014, and Kawano et al. para. 0006 and 0011) and/or (2) solidification materials for use in road construction which produce little or no dust when the cement is sprayed or mixed, presumably onto or with the soil from the roadbed (*see* Kawano et al. para. 0020). In either case, however, the references do not relate to drywall joint compounds or such compounds including dust reducing additives for reducing the quantity of dust generated by sanding the compound. Rather, they relate to road construction. As such, they bear no relation whatsoever to the present invention.

Because Wakabayashi et al. or Kawano et al. fail to disclose a drywall joint compound and fail to disclose a drywall joint compound including a dust reducing additive in a sufficient quantity to reduce the quantity of particles that become airborne when sanding the hardened joint compound, the present invention as defined in new independent claim 50 is believed to be patentable over these references.

### **Kondrats**

Kondrats relates to surface coating compositions and methods for immobilizing airborne dust. The surface coating compositions are applied to surfaces as a thin coating of an aqueous emulsion. After drying, the composition enhances the settling of dust particles. To prepare a substantially airborne dust free room, a layer of the surface coating composition is applied to the floor of the room and is permitted to dry. The surface coating composition may include a cationic surfactant, a glycol ether, a mineral oil, and water which, when applied to a surface such as a floor of a room and allowed to dry, enhances the settling of dust particles. After use, the treated surface may be brushed or swept with a broom to remove and collect the spent composition along with the adhered dust particles.

Thus, the Kondrats reference does not relate to or disclose a drywall joint compound and suffers from the same shortcomings as Cole, Wakabayashi et al., and Kawano et al. discussed above. In addition, the surface coating composition is not intended to reduce the quantity of dust generated by anything but, rather, attempts to collect dust after it has already become airborne. Accordingly, the present invention as defined by new independent claim 50 is believed to be patentable over this reference.

### Kaplan

Kaplan discloses a flexible drywall joint compound comprising an acrylate, a biocide, a reinforcing agent such as polyamide fibers, a latex, a surfactant, a plasticizer, a coalescent, a fungicide, and a filler (see Kaplan col. 2, lines 15-24). Kaplan, however, does not disclose a joint compound that hardens or a joint compound that can be sanded to a smooth finish. Rather, even after the Kaplan mixture is allowed to fully set or cure, the joint compound is soft and “remains flexible indefinitely” (see Kaplan, col. 2, line 43 and col. 3, lines 49-50). Thus, Kaplan fails to disclose a hardenable sandable joint compound.

The present invention also solves a different problem than Kaplan. Specifically, the present invention solves the problem of reducing the quantity of dust generated when a joint compound is sanded, while Kaplan is directed to preventing cracks from forming in the joints of fabricated drywall surfaces when manufactured homes are moved from the point of fabrication to the home site (see Kaplan col. 2, lines 9-14). Kaplan is not concerned with the problem of dust generation and does not suggest the claimed joint compound composition as a solution to the problem of dust generation. Accordingly, the present invention is believed to be patentable over Kaplan.

### Patel and Trmata

Patel has been cited as teaching a joint compound comprising:

- (a) 1 to 100% of a filler,
- (b) 1 to 4 % of latex binder material,
- (c) 20-37% of water, and
- (d) 0.1 to 50% of wetting agents.

Based on this characterization of the Patel reference, the Examiner summarily concludes that, with respect to now canceled claims 45-48, “the requirements for rejection under 102(b) are met.”

Such a conclusion, however, without an explanation as to why this disclosure constitutes anticipation, cannot properly support a finding of anticipation. In addition, as explained more fully below, even assuming the Examiner’s assertion regarding the disclosure content of the Patel reference has merit, the conclusion drawn is erroneous.

Trmata is relied on as teaching a stucco composition for repairing wall material comprising:

- (a) 35 to 55% of calcium carbonate and 5-30% of sand or sawdust in combination as fillers,
- (b) 15 to 30% of binder material,
- (c) 15 to 30% of water, and
- (d) 3 to 30% linseed oil.

Based on this, the Examiner again summarily concludes that “the requirements for rejection under 102(b) are met” without any explanation as to why this disclosure constitutes anticipation.

Trmata relates to a low cost stucco mix, not a sandable drywall joint compound. Trmata is silent with respect to sanding the stucco and fails to recognize the problems associated with the dust generated upon sanding hardened compounds. It is well known that stucco compounds are not intended to be sanded. Since Trmata does not recognize the problem of dust generation or disclose a compound intended to be sanded, Trmata cannot be directed to solving the problem of dust generation, and does not offer a solution to this problem.

In addition, both Patel and Trmata fail to disclose a drywall joint compound including a dust reducing additive in a quantity sufficient to reduce the quantity of dust generated by sanding the hardened compound.

Patel discloses, in relevant part, a

setting, ready-mixed joint compound [which] can also include the following ingredients: defoamers, wetting agents, preservatives, fungicides, and binders, in the usual amount of about 0.1% to about 50% by weight of the composition.

(See Patel, column 7, lines 12-15.)

Thus, Patel merely discloses a joint compound that may include “defoamers, wetting agents, preservatives, fungicides, and binders, in the usual amount of about 0.1% to about 50% by weight of the composition.” These ingredient, however, are optional. In addition, Patel fails to disclose whether any of these ingredients could be used as dust reducing additives, which ones could be used as dust reducing additives, or how much of any particular ingredient would be required for it to serve as an effective dust reducing additive. Nor does Patel identify any specific defoamers, wetting agents, preservatives, fungicides and binders, or the amounts of such specific ingredients that would enable them to serve as dust reducing additives. Thus, Patel does not reveal or make known a joint compound including a dust reducing additive, and such a disclosure cannot be construed as disclosing, teaching, or suggestion the present invention.

To the extent that the Examiner believes Patel discloses adding 0.1% to 50% by weight of the composition of wetting agents, Applicant disagrees. The more plausible interpretation is that the joint compound can include 0.1 to 50 wt % of defoamers, wetting agents, preservatives, fungicides, and binders combined, not 0.1 to 50 wt % of each. Based on the more plausible interpretation, one is able to determine what the total combined quantity of defoamers, wetting agents, preservatives, fungicides, and binders may be added to the joint compound, but it is not possible to determine a specific range for any individual ingredient.

Applicant also disagrees with the Examiner’s apparent belief that the disclose in Patel of wetting agents constitutes disclosure of a dust reducing additive. As discussed above with respect to Williams and Struss et al, Patel offers no guidance as to what is meant by the term wetting agent. One skilled in the art would therefore expect the term to have its ordinary meaning. Accordingly, a wetting agent would be understood to be a “surface-active agent that, when added to water, causes it to penetrate more easily into, or to spread over the surface of, another material by reducing the surface tension of the water. Soaps, alcohols, and fatty acids are examples.” *Hawley's Condensed Chemical Dictionary* 1179 (13<sup>th</sup> ed. 1997) From this definition, one would not know to add a wetting agent to a compound in an attempt to reduce dust nor would one expect wetting agents to provide any dust reducing effect. Moreover, even if one were inclined to add a wetting agent to reduce dust, the term “wetting agent” is a very broad and encompasses a wide range of potential ingredients from which one would be required to choose.

Patel also fails to disclose which wetting agents may be used as a dust reducing additive, how much of a particular wetting agent should be added in order for it to serve as a dust reducing additive once a particular wetting agent has been identified, or even why the addition of a wetting agent is contemplated. Because Patel fails to disclose whether a wetting agent should be included in the joint compound formulation, whether wetting agents could serve as dust reducing additives, has failed to identify any specific wetting agents which could be used as dust reducing additives, and has failed to disclose how much of a particular wetting agent should be included in the formulation to serve as a dust reducing additive, new independent claim 50 is patentably distinguishable there from.

Although Applicant does not believe Patel or Trmata disclose a drywall joint compound including a dust reducing additive, assuming *arguendo* that they do, prior accidental production of an invention, where the character and function of the invention were not recognized, does not constitute anticipation. *Ralph W. McKee and Harold Perpall v. Graton & Knight Co.*, 32 U.S.P.Q. 89, 91 (4<sup>th</sup> Cir. 1937). Since any prior production of a drywall joint compound with a dust reducing additive by Patel and Trmata would have been purely accidental, and since Patel and Trmata did not recognize or appreciate the character or function of such a compound, it follows that Patel and Trmata do not anticipate or in any way render the present invention as defined by new independent claim 50 unpatentable. Stated another way, if a joint compound including a dust reducing additive was accidentally and unwittingly produced by Patel or Trmata, while the investigators were in pursuit of other and different results, without exciting attention and without it even being known what was done or how it had been done, it would be absurd to say that this was an anticipation of the present invention. See, *Tilghman v. Proctor* (1881).

Furthermore, if the alleged anticipating joint compounds included a dust reducing additive, that fact, so far as the reference shows, was not known to those who produced it or used it, and not being recognized as a new product with its distinctive characteristics, its production was purely an accident without profit to the art and without value as an anticipation. *Pittsburgh Iron & Steel Foundries Co. v. Seaman-Sleeth Co.*, 248 F. 705, 709 (3d Cir. 1918).

It is further noted that when a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate. *Mendenhall v. Astec Industries, Inc.*, 13

U.S.P.Q. 2d 1913, 1928 (Tenn. 1988), *aff'd*, 13 U.S.P.Q.2d 1956 (Fed. Cir. 1989). Again assuming *arguendo* that Patel may disclose a dust reducing additive, one would be required to pick and choose from the ingredients listed (i.e. defoamers, wetting agents, preservatives, fungicides, and/or binders alone or in combination), would be required to pick and choose the specific ingredient within each category of ingredients listed (i.e. the specific defoamer, the specific wetting agent (e.g. the specific soap, alcohol, or fatty acid), the specific preservative, etc., and would have to pick and choose the amount of each ingredient to be used in order to formulate a drywall joint compound including a dust reducing additive capable of reducing the formation of airborne dust particles. In fact, the Office Action itself supports the conclusion that Patel does not anticipate the present invention since the Examiner was required to choose wetting agents from the list of ingredients (i.e. defoamers, wetting agents, preservatives, fungicides, and binders) disclosed in the reference. Accordingly, Patel does not anticipate or in any way render the present invention unpatentable.

The Patel and Trmata references also fail to provide an enabling disclosure of the claimed invention. Since the Patel and Trmata references do not mention of dust generation, dust reduction, or dust reducing additives, there is no way that one skilled in the art of drywall joint compounds could, without the benefit of the present invention, take the teachings of the references in combination with his own knowledge of the particular art and be in possession of the present invention. In addition, since the Patel reference provides no direction or guidance regarding the use of wetting agents and one could not practice the present invention without undue experimentation, it further follows that Patel does not provide an enabling disclosure of the present invention. It is only through hindsight and reading in the teachings and insights learned from the present application that Patel and Trmata can be construed as having disclosed the present invention.

Moreover, the Trmata stucco compound specifically employs linseed oil which is a well known drying oil. Drying oils such as linseed oil oxidize and polymerize (or cross-link) upon exposure to air to form a hard, dry film. Such a drying oil would produce a hard compound that would be very difficult to sand. In addition, as linseed oil polymerizes, any dust reducing effect would disappear. While an appropriate quantity of linseed oil may have a temporary dust reducing effect, this effect is lost with time. Trmata, however, discloses that the stucco mix is

"preferably aged for a few weeks before being put into containers to permit the cellulose glue to more thoroughly wet the calcium carbonate powder." (Trmata, page 3, lines 16-18) Allowing the mix to age for a few weeks before being put into containers would tend to allow the linseed oil to polymerize and, consequently, would render the linseed oil ineffective as a dust reducing additive. In addition, if the stucco mixture had not already polymerized before being applied to a surface, such a mixture would polymerize very quickly upon application to a surface.

Trmata also discloses that the stucco mix preferably includes a cobalt siccative. (Trmata, page 2, line 16). Cobalt siccative serves to accelerate and promote the drying of the linseed oil and further prevents the linseed oil from having any dust reducing effect. Thus, the Trmata reference contains teachings that are contrary to what would be required to use linseed oil in a manner that would allow it to serve as a dust reducing additive. In fact, the teaching of the reference makes it clear that the linseed oil would not serve as a dust reducing additive when used in the manner described.

The present invention as defined by new independent claim 50, on the other hand, is directed to a "drywall joint compound" and it is well known that drywall joint compounds are sanded. Thus, the words "drywall joint compound" give meaning to the claim and properly define the invention. In view of the foregoing, new claim 50 is believed to be patentable over the Patel and Trmata.

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Claim 49 stands rejected under 35 USC §102(b) as being anticipated by or, in the alternative, 35 USC §103(a) as being unpatentable over Kaplan, Patel, or Trmata. Applicant disagrees.

Claim 49 is directed to a drywall joint compound having an initially paste-like consistency for filling joints between adjacent wallboard panels and a hard sandable condition after being applied to a wallboard joint and allowed to harden. The joint compound comprises a filler, a binder, from about 1.5 to about 20 percent dust reducing additive, and water. When the hardened compound is sanded as described in the specification, it generates a quantity of dust having a size of less than 10 microns which is less than 15 mg/m<sup>3</sup> and is at least 75% less than the amount that would be generated if the joint compound contained no dust reducing additive.

First, Applicant disagrees with the Examiner's conclusion that it would be reasonable to expect the compositions of Kaplan, Patel, or Trmata to possess the presently claimed properties because the compositions contain the same components as and are essentially the same as the present claimed composition. The Examiner has not indicated where Kaplan, Patel, or Trmata disclose compositions that are "essentially the same as the present claimed invention" <sup>and</sup> ~~and~~ in particular, a joint compound containing a dust reducing additive <sup>drywall</sup> Furthermore, Applicant believes it would be unreasonable to expect anyone to ~~drywall~~ add anything to the Kaplan, Patel, or Trmata drywall joint compounds in such a manner that the quantity of dust generated by the hardened joint compound would be reduced because Kaplan, Patel, and Trmata do not mention dust, do not mention dust reduction, do not mention which, if any, ingredients would serve to reduce the level of dust, and do not mention the quantity of such unidentified ingredients that would have to be added to reduce the level of dust. Applicant also believes it is even more unreasonable to expect one to add, or to be able to add, any ingredient to achieve a 75% reduction in the level of dust as defined in claim 49.

With respect to the Examiner's comment that the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations regarding the prior art joint compounds, Applicant notes that, even if the Examiner had requested Applicant to show that the prior art does not possess the claimed properties, because Kaplan, Patel, and Trmata fail to disclose reducing the quantity of dust generated by a joint compound by adding a dust reducing additive, it would be impossible for Applicant to conduct such an investigation. There are simply too many unknowns and Applicant would have to make too many assumptions about what formulation to begin with, what ingredients listed in the prior art may constitute dust reducing additives, and how much of the ingredient should be added.

*Commenting on the difficulty of testing the prior art compounds*

Furthermore, testing the prior art compounds overlooks the fact that the invention of claim 49 is not simply directed to a joint compound having a particular dust generating characteristic, but rather is directed to reducing the quantity of dust generated by the joint compound by 75%. Thus, regardless of the formulations disclosed by the prior art, the prior art does not disclose adding a dust reducing additive to reduce the quantity of airborne dust of the formulations disclosed by a certain percentage.

The Examiner also states that “an otherwise old composition is not patentable regardless of any new or unexpected properties” citing *In re Fitzgerald et al.* (205 USPQ 594 (CCPA 1980) (see eg. page 5, 6, 11, 12). Applicant has reviewed *In re Fitzgerald et al.* and disagrees that it stands for the proposition stated by the Examiner.

~~In addition to mischaracterizing the holding of *In re Fitzgerald*, the Examiner’s reliance on *In re Fitzgerald et al.* is misplaced.~~ While Applicant disagrees that the compositions of claim 49 is old, claim 49 is directed to compound including a dust reducing additive that reduces the quantity of dust to less than 15 mg/m<sup>3</sup> and is at least 75% less than the amount that would be generated if the joint compound contained no dust reducing additive. None of the cited references disclose, teach, or suggest such a joint compound.

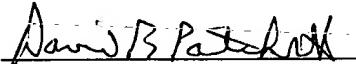
~~(D)~~ Applicant also disagrees with the Examiner’s statement that “even if assuming that the prior art processes do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive process because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art.” First, Applicant disagrees that the invention subject matter appears within the generic disclosure of the prior art, and the Examiner has failed to point out where such generic disclosure can be found. The prior art does not disclose reducing the quantity of dust generated while sanding or abrading a hardened drywall joint compound, does not disclose filling joints by providing a drywall joint compound including a dust reducing additive that generates 75% less airborne particles than it would generate without the dust reducing additive or generates a quantity of airborne particles having a size of less than 10 microns which is less than 15 mg/m<sup>3</sup>. Nor is there any suggestion or motivation in the prior art to modify the prior art so the level of airborne dust generated by any of those compounds would be reduced. Kaplan, Patel, and Trmata merely disclose that compounds can be made by mixing the various ingredients together using conventional techniques.

Since all claims are believed to be patentably distinguishable from the prior art, allowance of the claims is respectfully solicited. Please charge any fees required to enter this Response/Amendment or credit any overpayments to Deposit Account No. 13-3723.

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Respectfully submitted,

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## **Appendix A**

### **Version with Markings to Show Changes Made**

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**Serial No. 09/821,392**

**Filed: March 29, 2001**

**For: LOW DUST WALL REPAIR COMPOUND**

#### **In the Claims**

**Claims 24-48 have been canceled, and claims 50-65 are new.**